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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,713	06/20/2003	Takeshi Koizumi	5328-12	7563

27799 7590 03/16/2006

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EXAMINER

BAUSCH, SARA E L

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/601,713	Applicant(s) KOIZUMI ET AL.	
	Examiner Sarae Bausch	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1, 4, and 9.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Continuation.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

CONTINUATION

1. The amendment filed 03/02/2006 under 37 CFR 1.116 in reply to the final rejection has been entered. The rejections of claims 1, 4, and 9 in the final office action mailed 11/30/2005 is maintained. Claims 1, 4, and 9 are pending while claims 2-3, 5-8 and 10-11 are canceled.

2. Applicant traverses the rejection of claims 1, 4, and 9 under 102(b) as being anticipated by Sorensen et al. on page 3-4 of the response mailed 03/02/2006. The response asserts that Sorensen does not teach a PCR primer or an oligonucleotide that comprises a phosphate group at the 5' terminus and applicant asserts that chemically synthesized primers have hydroxyl groups at both ends (5' and 3') and in order to have a phosphate group at either end, a phosphorylation reaction must be conducted. Applicant asserts that Sorensen does not disclose such a phosphorylation reaction nor does Sorensen provide any teaching or suggestion that a phosphate at the 5' end of a primer will improve the PCR amplification efficiency as would result from the method of claim 1 and 4. This response has been thoroughly reviewed but not found persuasive.

With regard to applicants remarks that chemically synthesized primers have hydroxyl groups at both ends, the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. (see (MPEP 716.01(c)). Additionally, Sorensen et al. does teach a PCR primer that comprises a compound at the 5' terminus that is a phosphate group because Sorensen et al. teach

Art Unit: 1634

a random primer, which will comprise specific and nonspecific bases at the 5' terminus which includes phosphate groups. Furthermore, with regard to applicants remarks that Sorensen does not provide any teaching or suggestion that a phosphate at the 5' end will improve PCR amplification efficiency, neither claim 1 nor claim 4 require that the PCR primer improves efficiency of PCR amplification, both claim 1 and claim 4 are drawn to a method for amplifying a target DNA fragment by providing a PCR primer and amplifying the target DNA.

Applicant assert that Sorensen disclose a combination of non-biotinylated degenerate primer and a biotinylated non-degenerate primer and assert that claim 9 recites that the biotinylated PCR primer is degenerate. Applicant assert that Sorensen does not disclose or suggest the use of an asymmetric PCR primer and therefore claim 9 is not anticipated by Sorensen. This response has been thoroughly reviewed but not found persuasive. Claim 9 does not require that the biotinylated PCR primer is degenerate, Claim 9 recites a method for amplifying a target DNA fragment comprising providing a **PCR primer** that comprises biotin at the 5' terminus and amplifying said target DNA fragment using the PCR primer wherein said PCR is **either** one asymmetric PCR or degenerate PCR. The claim does not require that both PCR primers are degenerate, the claim only requires that the PCR primer comprises biotin at the 5' terminus and that amplification of target DNA is done by either asymmetric PCR or degenerate PCR. Sorensen et al. teach degenerate PCR by amplifying target DNA using a PCR primer labeled with biotin at the 5' terminus (see page 7118, 1st column, last paragraph). With regard to applicants remarks that Sorensen does not disclose or suggest the use of an asymmetric PCR primer, the claims do not require the use of an asymmetric PCR primer.

Art Unit: 1634

For these reasons, and the reasons made of record in the previous office actions, the rejection is maintained.

3. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarae Bausch whose telephone number is (571) 272-2912. The examiner can normally be reached on M-F 10am-7pm.

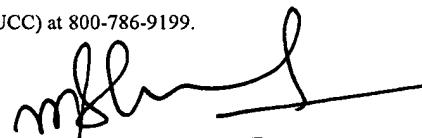
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



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